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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,275	01/19/2001	Toshio Kobayashi	SHC0104	1331

7590

09/12/2002

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EXAMINER

GUARRIELLO, JOHN J

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 09/12/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766275

Applicant(s)

Kobayashi et al.

Examiner

John Guarnello

Group Art Unit

1771

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 9/30/2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-6 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-3, 6 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4/5
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

Election/Restriction

15. The Examiner acknowledges the affirmation, paper # 7 of 7/30/2002, of the Restriction requirement of Group I, claims 1-3, 6 to the composite stretchable sheet. Group II, claims 4 and 5, drawn to the method of making, the non-elected invention, are withdrawn. Applicant's arguments regarding the method claims are not limited as to a specific manner of joining the fibrous assembly to the elastic sheet at binding sites (spots) arranged intermittently have been considered, but the Examiner disagrees because the method claims do not require that the binding sites (spots) necessarily coincide with the binding sites intermittently arranged in the article claims, especially since no parameters as to the dimensions of the sites (spots) has been evidenced. The traversal of the Restriction requirement regarding the sheet cannot be made by another method or process, has been considered but not persuasive for reasons noted above. The Restriction is made final.

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Claim Rejections - 35 USC § 112

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claims 1-3 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 7 and 10 , it is not clear what the terms “sites” encompasses since the instant specification only describes “spots” as noted in paragraph # 19.

In claim 3, line 2, it is not clear what the term “spots” encompasses since claim 1 states “site” not spots. This is a lack of antecedent basis to claim 1.

In claim 6, line 2, it is not clear why this claim depends on non-elected claim 4, it should depend upon claim 1 since claim 1 is the article sheet, and claim 4 is directed to the process of making the article, sheet.

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18. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

19. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The term “sites” has no support in the specification as filed. The term “sites” is not equivalent to “spots”. The term “sites” is new matter and should be deleted. The instant specification on pages 6, 7, 9, 10, 16, 17 and 22 only describes the binding areas as “spots” not sites.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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21. Claims 1-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morman 5,116,662.

Morman describes multi-direction stretch composite elastic material including at least one elastic sheet which means that the sheet is elongatable about 60%, i.e. stretched, (column 1, lines 60-68). Morman describes “nonelastic” as not falling in the definition of elastic, (column 2, lines 11-14).

Morman describes a composite material which refers to at least one sheet which is stretched and one necked (non-elastic) material, which are joined together in at least three locations corresponding to the instantly claimed binding spots, (column 3, lines 30-45). Morman describes elastic sheets, (column 7, lines 57-68; column 8, lines 1-63). Morman describes the non-elastic materials are nonwovens made of polyolefins and similar polymers including ethylene copolymers, (column 4, lines 44-64). Morman differs from the claimed invention because it is silent about the aspect of non-elastic and the specific composition of the ethylene copolymer.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the necked material, see Figure 2B, so that the binding spots correspond between the sheet and the fibrous assembly and are similar in effect to the bonding locations of the two layers of elastic and non-elastic sheet motivated with the expectation that improved properties of resilience and stretch and recovery, (column 4, lines 67-68), are evident when the binding spots overlap. Regarding the composition of the ethylene copolymer Morman describes blends of polyolefin material which is incorporated by reference in 4,663,220 (column 11, lines 55-68; column 13, lines 40-57; of '220), which when blended under appropriate conditions, (column 8, lines 34-49) one of ordinary skill in the art would be able to optimize the amounts of the ethylene propylene butene copolymers to join the two layers.

Double Patenting

22. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so

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as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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23. Claims 1-3, 6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 09/941566. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the correspondence of the relative binding spots of the elastic sheet of '566 in reference to the inelastic fibrous sheet so that the bonding zones (similar to binding spots) would be expected to improve the the similar properties of flexibility, see abstract.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

24. Claims 1-3, 6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 09/812299. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the

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time the invention was made to modify the correspondence of the bonding areas of the elastic sheet in reference to the fibrous layer of inelastic fibers such that the flexibility would be an improvement regarding the claimed invention. '299 describes the similar components of elastic material and inelastic material, see claims 1-3 of '299.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 2002/0053755, Kobayashi et al. Describes a composite web and it cited for interest as being pertinent to the claimed subject matter .

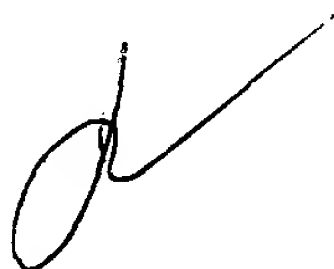
26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose telephone

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number is 703-308-3209. The examiner can normally be reached on Monday to Friday from 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris , can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



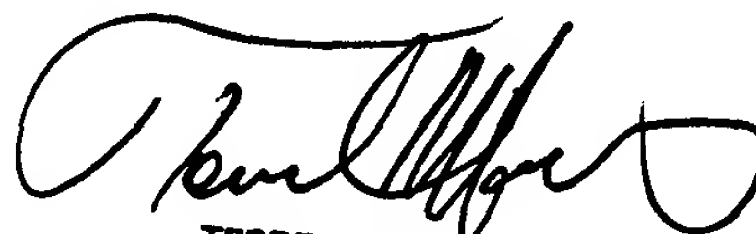
John J. Guarriello:gj

Patent Examiner

August 18, 2002

August 30, 2002

September 9, 2002



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